

REMARKS

In response to the Office Action, Paper No./Mail Date 20081129, dated December 8, 2008, Applicant has carefully studied the references cited by the Examiner and the Examiner's comments relative thereto.

Claims 1, 22, 26, 38, 52, and 55-59 have been amended.

Claims 39, 49-51 have been cancelled.

No new claims have been added.

Claims 1-10, 22, 26, 38, 40-48, and 52-60 remain in the application.

No new matter has been added.

Reconsideration of the application, as amended, is respectfully requested.

Claim Objections

The Examiner objected to Claim 39 under 37 CFR 1.75(c) as an improper dependent claim because it fails to further limit the subject matter of a previous claim.

Claim 39 has been cancelled from the application. Accordingly, the Examiner's rejection is moot.

35 U.S.C. § 112(b), first paragraph

The Examiner rejected Claims 1-10, 22, 26, 38-48, and 52-60 under 35 USC 112, first paragraph as failing to comply with the written description requirement. The Examiner stated that:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Since the threaded portion being part of the structure of the container or the preform in accordance with the specification of the present invention, the threaded portion is made of the same material as the container or the preform for forming a blow molded container. However, the threaded portion as presently claimed could be made of a material that is different from container (sic) or the preform. That is not fully supported by the original disclosure of the present invention.

Because Claim 39 has been cancelled, the Examiner's rejection is moot.

Amended independent Claim 1 recites "a threaded portion for the container adapted to receive a cooperating closure, wherein said threaded portion is formed from at least one of said outer layer formed as a foam and both said outer layer formed as a foam and said inner layer". The threaded portion must be formed by one of the layers enumerated in the claims,

and the threaded portion cannot be formed from “a material that is different from the container or the preform.” As pointed out by the Examiner, “the threaded portion being formed from the same materials as the container” is supported by the specification. Therefore, amended Claims 1-10, 22, 26, 38-48, and 52-60 comply with 35 USC 112, first paragraph.

Each of independent Claims 22, 26, 38, 52, 55-57, and 59, as amended, contains at least the same limitations as Claim 1. For the same reasons discussed above, Claims 22, 26, 38, 52, 55-57, and 59, as amended, comply with 35 USC 112, first paragraph.

Claims 40-48, 53, 54, 57, 58, and 60 contain at least the same limitations as Claim 1 and therefore comply with 35 USC 112, first paragraph.

Accordingly, withdrawal of the Examiner’s rejection of Claims 1-10, 22, 26, 38, 40-48, and 52-60 under 35 U.S.C. § 112, first paragraph is respectfully requested.

35 U.S.C. § 112(b), second paragraph

The Examiner rejected Claims 22, 38-44, 47, 48, 52-54, and 57-60 under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner stated that:

A multilayer preform could be in any configurations other than in the form of a container in accordance with the claims. This does not seem within the scope of the present invention. It is suggested that ‘a multilayer preform in the form of a container’ would be sufficient to overcome the 112 issues. In addition, since the threaded portion being part of the structure of the container or the preform in accordance with the specification of the present invention, the threaded portion is made of the same material as the container or the preform. However, the threaded portion as presently claimed could be made of a material that is different from container (sic) or the preform.

Claim 39 has been cancelled, therefore, the Examiner’s rejection is moot.

A preform is defined as “any of various uncompleted objects of manufacture after preliminary shaping” (see <http://dictionary.reference.com/browse/Preform>). Preforms for forming a blow molded container, however, have a typical shape well-known in the art. Exemplary preforms for forming a blow molded container are shown in the attached website printouts from Chemco Group and PET Preforms. As illustrated in the printouts, preforms for forming a blow molded container are not “in the form of a container”, but such preforms do

have a typical shape known in the art. Incorporating the Examiner's suggested language of a "preform in the form of a container" would be inappropriate. Claims 22, 38, 40-44, 47, 48, 52-54, and 57-60 indicate that the preform is for "forming a blow molded container". Therefore, the preform of Claims 22, 38, 40-44, 47, 48, 52-54, and 57-60 cannot be in "any configurations other than in the form of a container", and the Applicant particularly points out and distinctly claims the subject matter regarded as the invention.

Claims 22, 38, 40-44, 47, 48, 52-54, and 57-60 have been amended to recite a threaded portion formed from the same plastic layers that form the container or the preform.

Claims 56 and 59 have been amended to recite "a first outer layer" and "a fifth inner layer" as suggested by the Examiner.

Accordingly, withdrawal of the Examiner's rejection of Claims 22, 38, 40-44, 47, 48, 52-54, and 57-60 under 35 U.S.C. § 112, first paragraph is respectfully requested.

35 U.S.C. § 102(b)

The Examiner rejected Claims 1, 2, 5, 8-10, 22, and 26 as being anticipated under 35 U.S.C. § 102(b) by WO 98/16364 to Clarke for METHOD OF INJECTION MOULDING A FOAMED ARTICLE. Corresponding U.S. Patent No. 6,358,446 to Clarke was relied on by the Examiner for convenience. The Examiner stated:

Applicant contends that Clarke does not teach a blow molded container wherein the threaded portion is comprised of an outer layer. The examiner respectfully disagrees. Clark teaches a blow molded bottle comprising three layers: an inner non-foamed layer, an intermediate foam layer, and an outer non-foamed layer... As the claim is not specific about the position of the outer layer relative to the container, i.e., the foam layer defining an outermost surface of the container exposed to external environment, the claimed outer layer could be any layer of the container depending on the direction in which the container is looking at the container.

Claim 1 of the application, as amended, recites (underlining added):

A blow molded container, comprising:
an inner layer of plastic suitable for blow molding;
an outer layer of plastic suitable for blow molding contacting said inner layer, said outer layer of plastic formed as a foam having foam cells containing one of carbon dioxide and nitrogen; and
a threaded portion for the container adapted to receive a cooperating closure, wherein said threaded portion is formed from at least one of:

a) said outer layer formed as a foam; and

b) both said outer layer formed as a foam and said inner layer.

The Applicant strongly disagrees with the Examiner's comments that the "intermediate foam layer of Clark broadly reads on the claims" foam layer of the present invention. Clarke **explicitly** teaches away from a threaded portion formed from a foam. Clarke does not have a threaded portion formed from a foamed layer. Clarke **explicitly** states that the "mould is closed to delimit the injection volume to that of the neck portion 51 and the expandable portion", while **the threaded portion remains unfoamed** "**even with relatively high concentrations of blowing agent**" (see Col. 9, lines 10-22; and Figs. 1-4 and 16-20). The threaded portion of Clarke is not disposed in the mould where the foaming of the polymer takes place and therefore **cannot be formed from a foam** (see Figs. 1-4 and 16-20). As a result, the Clarke reference cannot properly serve as a basis for rejection of amended independent Claim 1 or Claims 2, 5, and 8-10, which depend therefrom, under 35 U.S.C. § 102(b).

Because independent Claims 22 and 26 contain at least the same limitations as Claim 1, the Clarke reference cannot properly serve as a basis for rejection thereof.

The Examiner also rejected Claims 38-40 and 42-48 as being anticipated under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Clarke. Claim 38, as amended, recites "a threaded portion for the preform adapted to receive a cooperating closure, wherein said threaded portion is formed from at least one of said outer layer formed as a foam and both said outer layer formed as a foam and said inner layer". Clarke does not have a threaded portion formed from a foamed layer. Clarke discloses that the "mould is closed to delimit the injection volume to that of the neck portion 51 and the expandable portion" while **the threaded portion "remains unfoamed even with relatively high concentrations of blowing agent"** (see Col. 9, lines 10-22; and Figs. 1-4 and 16-20). The threaded portion of Clarke is not disposed in the mould where the foaming of the polymer takes place and therefore cannot be formed from a foam (see Figs. 1-4 and 16-20). As a result, the Clarke reference cannot properly serve as a basis for rejection of amended independent Claim 38 or Claims 39, 40, and 42-44, which depend directly therefrom, under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a).

Claim 39 has been cancelled, therefore, the Examiner's rejection is moot.

35 U.S.C. § 103(a)

The Examiner rejected Claims 3, 4, 6, 7, and 41 as obvious over Clarke in view U.S. Patent No. 6,485,819 for ALIPHATIC-AROMATIC COPOLYESTERS to Hayes under 35 U.S.C. § 103(a). The Examiner has failed to establish a prima facie case of obviousness in regards to Claims 3, 4, 6, 7, and 41 because the cited references do not contain any motivation or suggestion to combine the references.

Dependent Claims 3, 4, 6, and 7 contain at least the same limitations as independent Claim 1, as amended, namely, a blow molded container having “a threaded portion for the preform adapted to receive a cooperating closure, wherein said threaded portion is formed from at least one of said outer layer formed as a foam and both said outer layer formed as a foam and said inner layer.” Dependent Claim 41 contains at least the same limitations as independent Claim 38, as amended, namely, a preform having “a threaded portion for the preform adapted to receive a cooperating closure, wherein said threaded portion is formed from at least one of said outer layer formed as a foam and both said outer layer formed as a foam and said inner layer”.

The Examiner relies on Hayes to cure a defect of Clarke, namely, that Clark “does not specifically disclose the plastic resin made for polyethylene terephthalate (PET). While Hayes does disclose plastic resin made of PET, a thorough examination of Hayes shows it is completely devoid of any disclosure regarding multilayer objects, such as a bottle and a preform, comprised of identical materials. Hayes is also devoid of any disclosure of a threaded portion formed from a foamed layer. Therefore, Hayes does not cure the defects of Clarke. Neither Clarke nor Hayes teaches or suggests a blow molded container or a preform having “a threaded portion for the preform adapted to receive a cooperating closure, wherein said threaded portion is formed from at least one of said outer layer formed as a foam and both said outer layer formed as a foam and said inner layer.”

Accordingly, neither the Clarke nor Hayes reference provides any motivation or suggestion to combined the references under 35 U.S.C. § 103(a), as suggested by the Examiner. As a result, no combination of references can properly serve as a basis for rejection of independent Claim 1 or Claims 3, 4, 6, and 7 which depend therefrom, and independent Claim 38 or Claim 41 which depends therefrom, under 35 U.S.C. § 103(a). Withdrawal of the rejections under 35 U.S.C. § 103(a) is requested.

Double Patenting

The Examiner has provisionally rejected Claims 1-10, 22, 26, 38, 40-48, and 52-60 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Patent Application Ser. No. 11/384,979. The Examiner noted that, “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the ‘979 patent application fully encompass the claimed subject matter.”

Claim 39 has been cancelled from the application, therefore, the Examiner’s rejection of the claim is moot. As discussed above, Claims 1-10, 22, 26, 38, 40-48, and 52-60 have been amended, either directly or indirectly, and Applicant believes the claims of the application are allowable over the art of record. Accordingly, the Double Patenting rejection is the only remaining rejection of the Examiner.

The Applicant requests that the Double Patenting rejection be withdrawn. The claimed invention of the present invention and the invention of the ‘979 patent application are directed to separate inventions. Pursuant to MPEP 804(I)(A)(1), because the “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the present application (the earlier filed of the two pending applications), and the later-filed application is rejectable on other grounds, the Examiner is requested to withdraw the rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. The Applicant believes the Double Patenting rejection is improper and reserves the right to traverse the rejection at a later date, if necessary.

The other references cited by the Examiner, but not applied, have been studied and are not considered to be any more pertinent than the references relied upon by the Examiner.

It is submitted that the claims distinctly define the Applicant’s invention and distinguish the same from the prior art. Reconsideration of the application, as amended, is respectfully requested. A formal Notice of Allowance is solicited.

While the Applicant’s attorney has made a sincere effort to properly define Applicant’s invention and to distinguish the same from the prior art, should the Examiner deem that other language would be more appropriate, it is requested that a telephone interview be had with the Applicant’s attorney in a sincere effort to expedite the prosecution of the application.